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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,310	09/24/2001	Wolfgang Ahlers	0050/49849	8387
26474	7590	02/25/2004	EXAMINER	
			PASTERCZYK, JAMES W	
		ART UNIT		PAPER NUMBER
		1755		(6)

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/937,310	AHLERS ET AL.
	Examiner	Art Unit
	J. Pasterczyk	1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 January 2002, 9/24/01
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____.                                   |

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1. This Office action is in response to the IDS filed 1/8/02 and the preliminary amendment filed 9/24/01.
2. The abstract of the disclosure is objected to because it lacks a structural formula for the basic phosphinamidite ligand, which would easily fit in the space allotted for an abstract.; the basic structure of I.1 would suffice. Correction is required. See MPEP § 608.01(b).
3. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification contains only a vague hint of the use of the present catalyst compound in the hydrocyanation of any substrate, let alone a particular one, this vague hint amounting to an invitation to experiment rather than placing the claimed invention in the hands of the public.
4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, l. 2, the obsolete Roman numeral terminology for the chemical groups has been superceded by the use of Arabic numerals. In the formulas, since X<sup>1</sup> is always a nitrogen-containing heterocycle it would be more descriptive and easier to follow if a simplified structural formula were used in their place, for example N with a hoop drawn around it in the manner that A<sup>1</sup> is now drawn. Likewise with X<sup>2</sup> and X<sup>3</sup> in the manner that A<sup>2</sup> and A<sup>3</sup> are now drawn. In the third line of the A<sup>1</sup> recitation it is not clear what "hetaryl" means; if it means --heteroaryl-- it is suggested the latter term be used. In the sixth line of A1 change "among" to --the group

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consisting of-- for clearly closed Markush language. In the first two lines of the X1 recitation, since the P atom has only valence clearly shown it appears as if only one nitrogen atom may be bound to it, not more than one as currently recited. In l. 4 change "among" to --the group consisting of--. In l. 5 change "hetaryl" to --heteroaryl--; in l. 8 change "among" to --the group consisting of--; in l. 11 change "may be" to --are--. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "B" in claims 1, 2 and 4 is used by the claim to mean "bridging group", while the accepted meaning is "boron." The term is indefinite because the specification does not clearly redefine the term. This is particularly pertinent since so many of these cyclic groups may be heterocycles.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "Y" in claims 3 and 4 is used by the claim to mean "S, O or NR", while the accepted meaning is "yttrium." The term is indefinite because the specification does not clearly redefine the term.

Further in claim 2, l. 6, 9 and 16, change "among" to --the group consisting of--; in l. 14 and 15 change "hetaryl" to --heteroaryl--; in l. 19 change "may be" to the definite --are--.

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Further in claim 3, text line 4, insert --or-- after "S,"; in the third from last line all of the commas in the R groups should be on the bottom of the line, not superscripted.

Further in claim 4, l. 3, change "among the" to --the group consisting of--; on p. 15 of the preliminary amendment, l. 6, change "can" to --is-- for definiteness, and in the next line delete "be" and change "in" to --to--. The entire block of recitation of D should probably be right justified as the other recitations are, in l. 4, 8 and 16 change "among" to --the group consisting of--; in l. 14 and 15 change "hetaryl" to --heteroaryl--. On p. 16 of the preliminary amendment, l. 3, change "may be" to --is--; in text l. 8 insert --or-- after "S,". On p. 17 of the preliminary amendment change "among" to --the group consisting of--.

In claim 5, l. 2, change the obsolete Roman numerals to the contemporary Arabic numerals 8-10; in l. 3 change "among" to --the group consisting of--.

In claim 6, l. 3, change "among" to --the group consisting of--.

In claim 9, l. 5, change the Roman numerals to the Arabic numerals; in l. 2 "the hydrocyanation catalyst" lacks antecedent basis, and in the last line "the hydrocyanation conditions" lacks antecedent basis since the hydrocyanation is only mentioned in claim 8, not claim 7 from which this claim depends.

5. Claim 10 provides for the use of the recited catalyst, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e.,

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results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by van Rooy et al., Recl. Trav. Chim. Pays-Bas, vol 115, pp. 492-498 (1996) (hereafter referred to as van Rooy).

van Rooy discloses the invention as claimed (abstract first two lines; p. 493, right column, structures 6-8 at the top, all structures at the bottom).

8. Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Wissing et al., WO 96/16923 (hereafter referred to as Wissing).

Wissing discloses the invention as claimed (abstract; ligand structures from p. 8-13).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JP



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2/23/04